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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,819	10/20/2003	Yasushi Shikata	03560.003386	2635

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EXAMINER	
THOMAS, JASON M	
ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/687,819	SHIKATA ET AL.	
	Examiner	Art Unit	
	Jason Thomas	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/687,819.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 3-12 have been considered but are moot in view of the new ground(s) of rejection. Although no new references have been introduced, the examiner has changed position and is now relying on Holman, thereby changing substantially the grounds of rejection by introducing a 102 rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 7 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Holman, U.S. Patent No. 5,285,278 (hereinafter Holman).

Regarding claim 1: Holman teaches a signal processing apparatus comprising: a receiving circuit for receiving data comprising print contents transmitted from a sender so as to be simultaneously receivable by a plurality of receivers (see [fig. 3], [fig. 5], [col. 3, ll. 14-26], [claim 28] for a receiving circuit which receives a broadcast television signal with embedded print data);

and a processing circuit for outputting, to a printer, print data in accordance with both of the data received by the receiving circuit and user information of a user of the signal processing apparatus (see [fig. 2, 41], [fig. 3, 42], [col. 7, ll. 31-33], [col. 9, ll. 41-64] for the circuitry to print data in accordance with both data received and user information) wherein the data received by the receiving circuit comprises a plurality of sub print-contents which is part of the print contents (see [fig. 5], [col. 10, ll. 53-57] for extracting a plurality of individual coupon messages from a single stream of coupon related data; see [col. 9, ll. 41-50], [cols. 10-11, ll. 62-6] where each individual coupon message makes up the whole of contents to be transmitted and where (the print contents), coupon related data, is received as well as stored to be printed from a memory device which holds the print contents), and wherein the processing circuit selects one of the plurality of sub print-contents in accordance with the user information (see [col. 11, ll. 52-60] where in accordance with interactive user information, provided by means of an indication of preference to retain a coupon, the processor selects one of the sub-print contents by issuing a "MARK" command), and obtains the print data from the selected sub print-content (see [col. 7, ll. 31-33], [col. 9, ll. 41-50] for printing the individual sub-print contents).

Regarding claim 3: Holman discloses a signal processing apparatus wherein the data transmitted so as to be simultaneously receivable by the plurality of receivers (see [claim 28] for broadcast television) includes data for

use in sequentially generating stimuli perceptible by a user via a perception device (see [col. 11, ll. 18-20] for displaying video on a TV monitor).

Regarding claim 4: Holman discloses a signal processing apparatus wherein the processing circuit includes at least a circuit for outputting, to the outside of the signal processing apparatus, a signal for requesting the print data or data from which the print data is obtainable, in accordance with data transmitted so as to be simultaneously receivable by the plurality of receivers and in accordance with information associated with a user of the signal processing apparatus (see [fig. 2, 42], [fig. 3, 42] for a circuit for outputting to cut out coupons; see also [fig. 5], [col. 3, ll. 14-26], [claim 28] for a receiving circuit which receives a broadcast television signal broadcast for a plurality of receivers with embedded print data to be printed).

Regarding claim 7: Holman discloses a signal processing apparatus wherein the user information includes at least information indicating a property of the user (see [fig. 5, 128], [col. 17, ll. 8-18] for user information such as the address stored in the signal processing apparatus).

Regarding claim 10: Holman discloses a perception apparatus comprising a perception device and a signal processing apparatus wherein the data transmitted so as to be simultaneously receivable by the plurality of receivers includes at least data for use in sequentially generating stimuli perceptible by a user via the perception apparatus (see [fig. 5], [col. 3, ll. 14-26], [claim 28] for a receiving circuit which receives a broadcast television signal

broadcast for a plurality of receivers with embedded print data to be printed; see also [col. 11, ll. 18-20] for video and a TV monitor).

Regarding claim 11: Holman discloses a printing apparatus comprising a signal processing apparatus and a printer for printing in accordance with the print data output from the processing circuit (see [fig. 2, 42], [fig. 3, 42] for a circuit for outputting to cut out coupons).

Regarding claim 12: Holman discloses a broadcasting method comprising the step of transmitting first data for producing print data to be printed by a printer (see [abstract], [col. 3, ll. 42-52], [col. 7, ll. 64-66] for a television signal that contains audio, video and coupon related data) and a plurality of second data specifying signal processing to be performed on the first data to produce the print data at a particular signal processing apparatus that receives the first data and the plurality of second data (see [col. 5, ll. 8-33], [col. 10, ll. 33-48] where a second data is an indicator that enables the viewer to either ignore the message or to specify signal processing to be performed such as extracting the coupon related print data for printing) in such a manner that data comprising the first data and the plurality of second data can be simultaneously received by a plurality of signal processing apparatuses wherein the signal processing apparatus selects one of the plurality of second data depending on the information associated with the user of the particular signal processing apparatus (see [col. 11, ll. 52-60] where in accordance with interactive user information, provided by means of an indication of preference to retain a coupon by the user

of the apparatus, the processor selects one of the sub-print contents by issuing a "MARK" command, whereas a user of another apparatus may decide to issue a "DELETE" command).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 5, 6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman in view of Remillard, U.S. Patent No. 5,504,519 (hereinafter Remillard).

Regarding claim 5: Holman is silent regarding information regarding behavioral history of the user.

Remillard teaches wherein the user information includes at least information indicating a behavior history of the user (see [col. 2, ll. 14-19] [col. 2, ll. 58-65]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to record the user behavioral history, as taught in Remillard, when providing advertisement offers to the user, as taught in Homan, because knowing the users behavioral history is a good way to more effectively promote products (see [col. 2, ll. 3-12]).

Regarding claim 6: The combined teachings of Holman, in view of Remillard, teach wherein a signal processing apparatus is further capable of indicating times at or for which the user perceived the stimuli generated on the basis of the data (see Remillard: [col. 2, ll. 58-65], [col. 6, ll. 5-11] where time/date stamps are used to monitor programs the user watches).

Regarding claim 8: Holman is silent regarding identification information.

Remillard teaches wherein the user information includes at least identification information for identifying the signal processing apparatus (see [col. 6, ll. 23-28], [col. 6, ll. 54-57] where the information includes the electronic device's ID).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to record a device ID, as taught in Remillard, when providing a means of receiving data from a remote location, as taught in Holman, because this provides a way for the headend facility to interact with a particular unit for polling events or other needs (see [col. 6, ll. 23-28], [col. 6, ll. 54-57]).

Regarding claim 9: Holman does not teach acquiring user information remotely.

Remillard teaches wherein the user information is acquired on the basis of data received by the receiving circuit (see [abstract] where the device is capable of receiving mail and other news and information services for the user of the apparatus).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide of means of receiving user information from a remote location, as taught in Remillard, when providing a means of sending advertisement data to users, as taught in Holman, because receiving additional user information from a remote source is a good way to keep the user informed of available programming (see [abstract]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623